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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/070,039	10/22/2002	Cristina Alonso-Alija	Le A 33 893	9715
27941	7590	11/15/2005	EXAMINER	
JEFFREY M. GREENMAN VICE PRESIDENT, PATENTS AND LICENSING BAYER CORPORATION 400 MORGAN LANE WEST HAVEN, CT 06516			PUTTLITZ, KARL J	
			ART UNIT	PAPER NUMBER
			1621	

DATE MAILED: 11/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/070,039	Applicant(s) ALONSO-ALIJA ET AL.	
	Examiner Karl J. Puttlitz	Art Unit 1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on reply filed 3/11/2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6 is/are pending in the application.
- 4a) Of the above claim(s) 1,2,5 and 10-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3,4 and 6-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

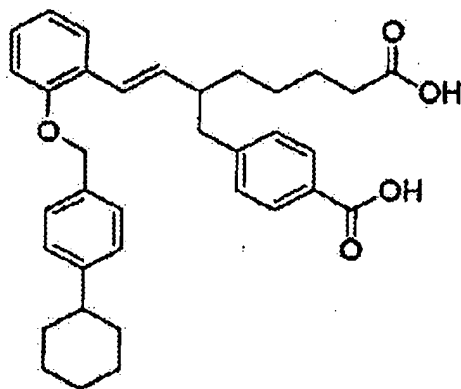
Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/25/2002</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

In the reply dated 3/11/2005, Applicant elected Group II, claims 3-11 for prosecution. Applicant also elected the following species:



Claims 3, 4, and 6-9 are readable thereon. Therefore, claims 1, 2, 5 and 10-18 are withdrawn from consideration. The method claims will be rejoined upon when limited to allowable compounds.

Applicant traverses the restriction is on the ground(s) that rules indicate that a common structure shared by all of the alternatives does not need to be a patentable advance over the art, so long as it occupies a large portion of the structure of the alternatives. Moreover, a common structural feature must be a patentable advance over the prior art. It may possibly mean only that the commonly shared structure should be "distinctive" in the sense that this structural feature has not previously been employed in the context of similar compounds of the prior art.

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However, as in the instant case, the situation involving the so-called "Markush practice" wherein a single claim defines alternatives (chemical or non-chemical) is governed by PCT 13.2. In this special situation, the requirement of a technical interrelationship and the same or corresponding special technical features as defined in Rule 13.2 shall be considered to be met when the alternatives are of a similar nature.

Specifically, when the Markush grouping is for alternatives of chemical compounds, they shall be regarded as being of a similar nature where the following criteria are fulfilled: (A) all alternatives have a common property or activity, and (B) a common structure is present, i.e., a significant structural element is shared by all of the alternatives, or in cases where the common structure cannot be the unifying criteria, all alternatives belong to a recognized class of chemical compounds in the art to which the invention pertains.

A significant structural element shared by all of the alternatives refers to cases where the compounds share a common chemical structure which occupies a large portion of their structures, or in case where the compounds have in common only a small portion of their structures, the commonly shared structure constitutes a structurally distinctive portion in view of existing prior art. The structural element may be a single component or a combination of individual components linked together.

The examiner understands that in the words "recognized class of chemical compounds" mean that there is an expectation from the knowledge in the art that members of the class will behave in the same way in the context of the claimed

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invention. In other words, each member could be substituted one for the other, with the expectation that the same intended result would be achieved.

However, based upon the general formula (I) in the claims, a significant structural element is not shared by all of the alternatives. Specifically, the formula is so broad that a common structure cannot be identified, or all alternatives do not belong to a recognized class of chemical compounds, based upon knowledge in the art.

The requirement is still deemed proper and is therefore made FINAL.

Claims 3, 4 and 6-9 are treated on the merits below:

Claim Rejections - 35 USC § 102

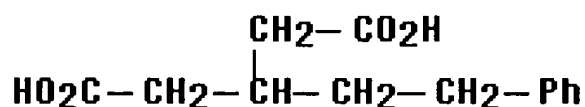
The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 3, 4, and 6-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Jones et al., Canadian Journal of Chemistry (1979), 57(9), 1025-32, Abstract, [retrieved on 31 October 2005] Chemical Abstracts, Columbus, OH, USA, Abstract Number 1979:523603 (Jones).

Jones teaches the following compound which anticipates the rejected claims within the meaning of section 102:



Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 3, 4 and 6-9 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 6, 7 and 14-19 of copending Application No. 10/070033 (conflicting application). Although the conflicting claims are not identical, they are not patentably distinct from each other. While the compounds covered in the conflicting application are of a different scope, the conflicting application covers compounds that teach or suggest the instant compounds of the rejected claims with the requisite particularity and guidance that the instant compounds would have been within the motivation of those of ordinary skill, and therefore, prima facie obvious.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

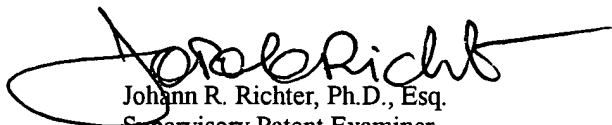
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karl J. Puttlitz whose telephone number is (571) 272-0645. The examiner can normally be reached on Monday to Friday from 9 a.m. to 5 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter, can be reached at telephone number (571) 272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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